

REMARKS

This response is intended as a full and complete response to the Office Action dated January 3, 2006. In view of the following discussion, the Applicant believes that all claims are in allowable form.

CLAIM REJECTIONS

A. 35 U.S.C. §103(a) Claims 1-6, 8-13, 15 and 23

Claims 1-6, 8-13, 15 and 23 stand rejected as being obvious over United States Patent No. 5,375,664 issued December 27, 1994 to *McDowell, et al.* (hereinafter referred to as "*McDowell*") in view of United States Patent No. 6,047,771 issued April 11, 2000 to *Roynestad* (hereinafter referred to as "*Roynestad*"). In response, the Applicant respectfully traverses the rejection.

McDowell discloses a pile driving apparatus that can drive piles into the ground to form a support structure for a column member of a building in a quick and safe manner. (Col. 1, Lines 5-10, Col. 3, Lines 30-35). The apparatus disclosed in *McDowell* teaches a boom providing a fixed or stationary support for a lead while a hammer drives a needle pile. The lead is coupled to the boom of an excavator in a manner that permits movement of the lead relative the boom in solely one plane. (Col. 5, Lines 67-68, Col. 6, Lines 1-2). Therefore, *McDowell* does not teach or suggest a lead mounting assembly pivotably coupled to a lead and having a mounting arrangement configured to allow rotation of the lead in a first plane, and a hydraulic actuator coupled to the lead and the lead mounting assembly, the hydraulic actuator adapted to control the pivotal orientation of the lead relative to the lead mounting assembly in second plane that is different than the first plane, as recited by claim 1; or a lead mounting assembly coupling a lead to a boom, the lead mounting assembly having a first boom mounting hole defining a first axis of rotation substantially perpendicular to the lead, wherein the lead is rotational relative to the lead mounting assembly about a second axis of rotation substantially perpendicular to the first axis of rotation, as recited by claim 10; or an attachment having a lead, a hammer slidably coupled to the lead and a

lead mounting assembly coupling the lead to a boom and configured to allow positioning of the lead in two planes relative to the boom, as recited by claim 23.

The Examiner concedes this in the Office Action dated January 3, 2006, however, the Examiner asserts that *Roynestad* bridges the substantial gap left by *McDowell*. However, the Applicant respectfully submits that *McDowell* and *Roynestad* cannot be meaningfully combined because there is no motivation to combine the two references. *McDowell* teaches a hydraulic pile driver used in conjunction with mobile tractors for piling. In contrast, *Roynestad* teaches a device attached to a stationary base for hauling a casing from a borehole or inserting casings down a borehole. *Roynestad* specifically teaches that “the device may be used to urge e.g. a pipe down into a predrilled bore hole.” (See *Roynestad*, col. 2, ll. 27-29.) The Applicant respectfully submits that one looking to modify a device for piling would not search apparatuses used with pre-drilled holes for modifications.

Moreover, even if the *Roynestad* and *McDowell* could be combined, the combined teaching do not teach all the elements claimed by the Applicant. Specifically, *Roynestad* teaches that the derrick 16 and drilling machine 24 may be turned in relation to the attachment frame 16' by cylinders 23, 23'. However, *Roynestad* does not teach or suggest:

- a direction in which the derrick is turned in relation to the attachment frame;
- pivotably coupling the derrick to the attachment frame, as recited in claim 1;
- having an actuator adapted to move the derrick relative to the attachment frame in a plane different than a plane in which the attachment frame rotates, as recited in claims 1 and 10;
- pivoting the derrick in relation to the attachment frame, as recited in claim 1;
- a shaft coupled between the derrick and attachment frame, as recited in claims 6 and 13;

- a cage shielding the hammer, as recited in claims 8 and 15;
- that the attachment frame allow positioning of the derrick in at least two planes relative to the boom, as recited in claim 23;
- a mounting plate having a curved surface coupled by a tab extending from the derrick, as recited in claim 24;
- a retainer securing an outer portion of a mounting plate and allowing rotation between the mounting plate and the derrick, as recited in claim 25;
- a mounting plate having a curved edge, as recited in claim 26;
- a retainer fastened to the derrick and extending over the curved edge of a mounting plate towards a pivot, as recited in claim 27;
- a retainer securing an outer portion of the mounting plate to the derrick while allowing rotation between the mounting plate and the derrick, as recited in claims 25 and 29; or
- a second boom mounting hole having a centerline parallel to the first axis of rotation and disposed on an opposite side of the second axis of rotation relative to the first boom mounting hole, as recited in claim 28.

A basic requirement of establishing a prima facie case of obviousness is that the prior art references must teach or suggest all the claim limitations. See, MPEP § 2143. The Applicant asserts that the Examiner has failed to establish a prima facie case because the claimed elements are not taught or suggested of from the references of record.

The mere fact that the references could be modified as to have produced the claimed invention is not evidence of obviousness unless the references suggest the desirability of the modification. *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir. 1992), *In re Gordon*, 221 U.S.P.Q. 2d 1125, 1127 (Fed. Cir. 1984). Additionally, when considering drawings as prior art, MPEP § 2125 requires the drawing to show all the claimed features and how they are put together (emphasis added).

Here, because *Roynestad* teaches turning of the derrick relative to an attachment frame without teaching of how, why or in which direction the derrick is turned relative to the attachment frame, the Examiner has expanded on the teachings of *Roynestad* to force the teachings of the prior art to fit the claimed elements and thereby support his conclusion of obviousness. This is impermissible under MPEP § 2125, § 2143.

Thus, the Applicant submits that independent claims 1, 10 and 23, and all claims respectively depending therefrom, are patentable over *McDowell* and *Roynestad*. Accordingly, the Applicant respectfully requests the rejection be withdrawn and the claims allowed.

B. 35 U.S.C. §103(a) Claims 7 and 14

Claims 7 and 14 stand rejected as being unpatentable over *McDowell* and *Roynestad* in view of the United States Patent No. 4,333,541 issued June 8, 1982 to *Doty* (hereinafter referred to as "*Doty*"). The Applicant respectfully traverses the rejection.

The teachings of *McDowell* and *Roynestad* are discussed above. As discussed above, *McDowell* and *Roynestad* fail to render obvious Applicant's independent claims 1 and 10 for the reasons discussed above.

Moreover, *Doty* fails to bridge the substantial gap left by either *McDowell* or *Roynestad*. *Doty* teaches that an elevation of a cylinder (in a vehicle mounted soil sampling device) may be adjusted by engaging cross pins to secure the overall position of a channel relative to a side plate. The section of which holes in which the cross pins are engaged do not limit the stroke (or travel) of the cylinder. Thus, *Doty* also fails to teach, show or suggest a lead mounting assembly pivotably coupled to a lead and having a mounting arrangement configured to allow rotation of the lead in a first plane, and a hydraulic actuator coupled to the lead and the lead mounting assembly, the hydraulic actuator adapted to control the pivotal orientation of the lead relative to the lead mounting assembly in second plane that is different than the first plane, as recited by claim 1; or a lead mounting assembly coupling a lead to a boom, the lead mounting

assembly having a first boom mounting hole defining a first axis of rotation substantially perpendicular to the lead, wherein the lead is rotational relative to the lead mounting assembly about a second axis of rotation substantially perpendicular to the first axis of rotation, as recited by claim 10.

Furthermore, claims 7 and 14 depend from independent claims 1 and 10, respectively and recite additional limitations. As such and for the exact same reasons set forth above, the Applicant submits that claims 7 and 14 are also not made obvious by *McDowell* and *Roynestad* in view of *Doty*. Therefore, the Applicants submit that claims 7 and 14 fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder.


CONCLUSION

Thus, the Applicant submits that all claims now pending are in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issuance are earnestly solicited.

If, however, the Examiner believes that any unresolved issues still exist, it is requested that the Examiner telephone Mr. Keith Taboada at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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